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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,590

10/16/2003

Cemal Shener

00167-460001

5126

7590

05/02/2006

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EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,590

Applicant(s)

SHENER ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-17 and 20-33 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8, 11-14 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Glowa et al. (U.S. Pat. 6,086,542) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 11142005.

As to the newly added limitations in claim 1, the channel in the sheath (60) (the space that accommodates the inner portion 30) is inherently "configured" to removably receive the inner portion (Nothing in the channel itself would prevent insertion and removal of the inner portion. In fact, this capability is inherent due to the fact that the inner portion would have had to have been inserted to be affixed to the sheath). The fact that the inner portion is fixed to the sheath does not diminish the claimed capability given to the channel. Perhaps Applicant would consider reciting that the inner portion is removably coupled to the sheath. Regarding the pressure sensing channel (52) and fluid channel (62) being "segregated to limit fluid communication between the channels", note tubular member (50) that exists between such channels.

As to the newly added limitations in claim 27, taking the arthroscope (36) as being the operative device positioned within the operative channel (42), the optical channel (within the arthroscope and thus within the inner portion) still houses an optical device (light guide).

As to the newly added limitations in claim 28, taking the arthroscope (36) as being the operative device positioned within the operative channel (42), the optical channel (within the

arthroscope and thus within the inner portion) still houses an optical device (light guide). In addition, there is a space between the operative device and the operative channel (42, Fig.2) which provides a flow path.

As to the newly added structural limitations of claim 30, note tubular member (50) which segregates the pressure sensing channel and the fluid channel as pointed out above. The method step of how it is used does not structurally limit the claim any more than what structure it may suggest and it doesn't suggest anything that more than what was originally claimed (i.e., alignment elements align the inner portion and the sheath).

As to new claim 33, and interpreting the structure of Glowa et al. as pointed out with respect to claims 27 and 28, Glowa et al. discloses an inner portion (30), an operative channel (42), an operative device (36), an optical channel (channel within 36 that houses optics), and sheath (60).

3. Claims 1-8, 11-17, 20-26 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Vukovic (Re. 32,158) for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 11142005.

As to the newly added limitations of claims 1 and 30, substantially all of the length of the channels (38,38) are segregated by the channel (40, Fig.3), any segregation along the length of these channels would at least *limit* fluid communication between them.

As to the newly added limitations of claims 28 and 33, the Examiner takes the position that the channel (44) itself is "configured" to receive an operative device while providing a fluid path. All this requires, of the channel, is that there is a space between the operative device and

the channel wall. There would inherently be such space due to the fact that any instrument capable of being inserted through channel (44) would have to be smaller in diameter than the channel wall.

Allowable Subject Matter

4. Claim 34 is allowed.
5. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive.

As to claims 1, 27, 28, 30 and 33 with respect to the Glowa et al. reference, the additional description set forth above in the rejections addresses the newly added limitations to these claims.

As to claim 29 with respect to the Glowa et al. reference, Applicant implies that the conventional coupling (which is assumed in Glowa et al.) between a pressure sensor and a pressure-sensing channel (port) is fragile, weak and so ill-conceived that the slightest rotation of the entire device will disconnect it. The Examiner finds this very hard to believe. The mere fact that the coupling between the pressure sensor and port (18), and the couplings between fluid

ports 16 and 20 with supply lines for that matter, are required to withstand at least some pressure above ambient pressure would suggest to the reasonable person that the coupling between these elements must be more than mere contact between elements. There must be a positive, force-withstanding connection (e.g., friction fit, bayonet, threads, snap-fit, etc.). Applicant contends that the Examiner has provided no support for maintaining that the "port (18) will, if properly connected, maintain its connection no matter how the port is rotated". How could it not? In any event, the Examiner's support, as pointed out above, is logic and common sense.

As to claims 1, 28, 30 and 33 with respect to the Vukovic reference, the additional description set forth above in the rejections addresses the newly added limitations to these claims.

As to claim 29 with respect to the Vukovic reference, surely the device of Vukovic is not too large or too heavy to be rotated about any axis (including the one claimed by Applicant). This is not an issue. In addition, Applicant can not expect the Examiner to believe that any connection of a supply tube, sensor, etc. to the valve (34) in Vukovic would not include at least a minimally secure coupling. The Examiner maintains his position as set forth above in the Examiner's discussion of claim 29 with respect to Glowa et al.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

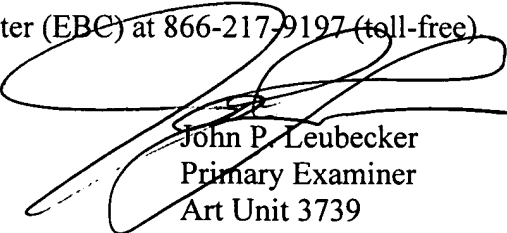
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl